

***Remarks***

Reconsideration of this Application is respectfully requested.

Claims 1-3 are pending in the application, with claim 1 being the independent claim.

New claims 5-10 have been added, with claims 5 and 8 being independent claims. Support for the new claims is provided by the originally-filed claims and throughout the instant disclosure. No new matter is included.

Applicant notes, with thanks, the withdrawal of the Objections to Drawings for claims 1-3 and the withdrawal of the finality of the rejection of the Office action mailed May 22, 2003 (USPTO Paper Number 9). Based on the following remarks, Applicant respectfully requests that the Examiner reconsider all rejections and that they be withdrawn.

The Applicant also thanks the examiner for the interview and summary (part of Paper No. 12) provided for the telephone interview conducted on October 23, 2003. The Applicant also thanks the telephone interviews held with Supervisory Patent Examiner Weilen Lo on October 28, 2003.

***Rejection of Claims under 35 U.S.C. 103(a)***

The Examiner has rejected claims 1-3 as being unpatentable over Rudolph (US Patent No. 5,265,595) "in further view of Dyrud et al." (U.S. Patent No. 5,819,731). The basis of the rejection by the examiner remained unchanged from the previous Action set forth in Paper No. 9, mailed May 22, 2003.

The Examiner additionally states that

The recitation of "an oxygen mask" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended

use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. The device of Rudolph/Dyrud is fully capable of performing the claimed limitations, because the invention is directed towards means for securing. [citations omitted]

Applicant respectfully disagrees. In regards to the substance of the rejection set forth in Paper No. 9 and substantially repeated in the Non-final Office Action mailed November 7, 2003, the Applicants maintain their arguments as set forth in the Reply filed on August 22, 2003.

Briefly, entanglement of the wearer's hair or otherwise ruining the wearer's hairstyle is not taught in either Rudolph or Dyrud, nor suggested as an important function provided by their inventions. Further, Rudolph does not teach a filtration mask. Dyrud teaches a filtration mask but does not teach a mask for measuring respiration and metabolism. Therefore, neither patent suggests a nexus to the other patent. There is no teaching or suggestion provided by either of these two patents to combine the two features of their respective masks to arrive at the instant invention of the applicant. Therefore, one of ordinary skill in the art could not have arrived at the Applicant's invention without the guidance of the Applicant's specification. Applicant maintains that the obviousness rejection made by the Examiner is merely hindsight reconstruction based upon the Applicant's disclosure.

It is further argued by the Applicant that the invention of the instant claims is directed to an *oxygen delivery mask*. Neither of the patents (US Patent No. 5,265,595 and U.S. Patent No. 5,819,731) cited by the Examiner in the obviousness rejection teaches or suggests an oxygen delivery mask. Applicant argues that the art cited is entirely deficient in this regard. The mask described in the '731 patent is a fibrous filtration mask and is entirely unsuitable for use as an oxygen delivery mask. The mask described in the '595 patent is unable to be used as an oxygen delivery mask, as discussed in detail by the Applicant *supra*, and in previous responses.

Applicant respectfully disagrees with the Examiner's argument that "oxygen mask" has not been given patentable weight. The preamble of the instant claims 1-3 do not merely imply intended use of a structure. Rather, the body of the instant claims depend upon the preamble and the structural limitations are not able to stand on their own. The claims are not directed toward a mask intended for the delivery of oxygen but toward an *oxygen mask*. The invention of claims 1-3 are directed toward an "oxygen mask having an improved means for being secured" and not towards a "means for securing." The Applicants note that the Examiner has quoted M.P.E.P § 2111.02 "Weight of Preamble," which also states that "[t]he preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "essential to point out the invention defined by the claim." *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951)." Applicants respectfully assert that the limitation "'oxygen mask'" breathes life and meaning into the claim. The oxygen mask, as described in the specification on page 2, lines 5-6 is designed especially for use by emergency rescue personnel. It is known by one of ordinary skill in the art, that emergency rescue personnel would be administering oxygen to patients in need thereof, as defined by current accepted emergency medical practice. Therefore, the use of the phrase "oxygen mask" in the preamble should be given patentable weight.

Based upon the preceding arguments, applicant therefore requests that the rejection of claims 1-3 under 35 U.S.C. 103(a) be withdrawn.

Absent further comment by the Examiner, the Applicant assumes that other secondary reference(s) besides Dyrud *et al.* are not included in the rejection, in spite of the wording "in further view of Dyrud et al." [emphasis added by Applicant]

***Conclusion***

All of the stated grounds of rejection have been properly traversed. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

  
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